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In re Application of
Joseph Anderson
Application No. 10/629,158
Filed: July 29, 2003
Attorney Docket No. JRAC-0001

: OFFICE OF PETITIONS
: :
: DECISION ON PETITIONS
: UNDER 37 CFR 1.181, 1.182
: AND 1.183

This is a decision on the "Petition to Correct Official Filing Receipt and/or Petition to Accord Priority Benefit 37 C.F.R. §§ 1.181, 1.182, or 1.183," requesting issuance of a corrected Filing Receipt which sets forth the claim for priority to the prior-filed provisional application; namely, Application No. 60/264,906, filed January 30, 2001.

The petitions are dismissed.

ISSUE

Petitioner states that the Official Filing Receipt in the subject application recognizes priority to co-pending International Application No. PCT/US02/0245, filed January 30, 2002, but does not recognize priority of the provisional application, No. 60/264,906, filed January 30, 2001.

Petitioner now requests recognition of the proper priority benefit and issuance of a corrected Filing Receipt. Accompanying the petition is an amendment using the suggested language of the USPTO Notice "Benefit Claims to Prior Applications under 35 U.S.C. §§ 119(e), 120, 121, and 365(c)," 1268 OG 89 (18 Mar. 2003).

DISCUSSION AND ANALYSIS OF PETITION UNDER 37 CFR 1.181

It is noted that the instant application did in fact publish with the above-noted PCT application, albeit as a foreign application under 35 U.S.C. § 119(a)-(d), but did not publish with the prior-filed provisional application. It is further noted that the "Declaration and Power of Attorney" filed in this application sets forth under 35 U.S.C. § 120 both the above-noted PCT and provisional applications. Additionally, note is made of the first line of the specification, which reads: "The present application claims the priority benefit of co-pending United States Provisional Application No. 60/264,906, and co-pending International Application No. PCT/US02/0245."

The priority claim to the provisional and PCT applications in both the first line of the specification and the Declaration and Power of Attorney was not properly stated.

Petitioner's attention is directed to MPEP 201.11 A. *Reference to Prior Nonprovisional Applications*, which states:

Any benefit claim that does not both identify a prior application by its application number and specify a relationship between the applications will not be considered to contain a specific reference to a prior application as required by 35 U.S.C. 120. Such benefit claim may not be recognized by the Office and may not be included on the filing receipt even if the claim appears in the first sentence of the specification or an application data sheet * * *.

To specify the relationship between the applications, applicant must specify whether the application is a continuation, divisional, or continuation-in-part of the prior application.

An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed ---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed ---," does not comply with 37 CFR 1.78(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. *See Manual of Patent Examining Procedure* (8th ed., August 2001), Section 201.11, Reference to First Application.

In view of the above, petitioner has not complied with the requirements of 37 CFR 1.78(a)(2)(i) in setting forth the proper relationship between the instant application and the PCT application. Further, as the first line of the specification is read, the present application is claiming benefit of the provisional application, which provisional application was filed more than one year from the filing date of the instant application. However, as the PCT application was filed within one year of the provisional application, it is proper for the PCT application to claim benefit to the provisional application.

Since petitioner did not specify the correct relationship of the PCT and provisional applications within the time period specified in 37 CFR 1.78(a)(2)(ii) and 37 CFR 1.78(a)(5)(ii), a petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) is now the proper avenue for obtaining benefit under 35 U.S.C. §§ 120 and 119(e) to the prior-filed PCT and provisional applications. Accordingly, petitioner is not entitled to a corrected Filing Receipt and the petition under 37 CFR 1.181 must be dismissed.

It is suggested that petitioner file a petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6). A petition thereunder is only applicable to those applications

filed on or after November 29, 2000 and is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

DISCUSSION AND ANALYSIS OF PETITION UNDER 37 CFR 1.182

37 CFR 1.182 states:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

Since correction of the priority data in an application is provided for in 37 CFR 1.78(a)(3) and 1.78(a)(6), it is inappropriate here to treat the petition under the provisions of 37 CFR 1.182. Accordingly, the petition must be dismissed.

DISCUSSION AND ANALYSIS OF PETITION UNDER 37 CFR 1.183

Petitioner additionally requests waiver under 37 CFR 1.183, but fails to specifically state the rule sought to be waived. The petition further fails to include the \$130 petition fee required for consideration of such a petition. Therefore, no consideration will be given on the merits of the petition under 37 CFR 1.183.

Further correspondence with respect to this matter should be addressed as follows:

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By fax: (703) 872-9306
 ATTN: Office of Petitions

Any questions concerning this matter may be directed to the undersigned at (703) 305-8680.

Frances Hicks
Frances Hicks

Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy